

R E M A R K S

REJECTION UNDER 35 USC §101

The rejection under §101 of claims 47-52 has been stated in the Office Action to be based on a failure of the claimed process to “specifically use technology to carry out any of the non-trivial claimed method steps within the body of the claims.” In other words, it is the position of the Office Action that recitation of “utilizing a computer system” in the preamble of previously amended claim 47 is not sufficient to associate the claimed method with technological steps. It is respectfully submitted that it has been long established that the recitations in a claim preamble can be given weight in circumstances when such recitations “breathe life” into the overall meaning of a claim, and that such was the circumstance with previously amended claim 47. However, since this issue appears to be merely one of form, and in order to expedite resolution of this formality, without intention of materially altering the scope of the claims, claim 47 has hereby been amended to include recitations of computer means in several of the pertinent steps of the claimed method. Claim 47 as amended clearly recites a method that implements technology.

Accordingly, it is respectfully submitted that the rejection under §101 should be reconsidered and withdrawn.

REJECTIONS UNDER 35 USC §103

The rejection of claims 47, 48, 51, and 52 under 35 USC 103 based on the Siegrist Jr. *et al.* reference (U.S. Pat. No. 5,652,842) (“Siegrist”) in view of the Borghesi *et al.* reference (U.S. Pat. No. 5,950,169) (“Borghesi”) is respectfully traversed.

Siegrist is limited to analyzing historical performance data of medical service providers. Unlike the present invention, Siegrist does not serve to bring together a particular customer having a particular need today with a service provider who is best able to provide that particular service today. (“Today” is intended to encompass the immediate future in this context.) If a patient needs a gall bladder operation,

Siegrist would be able to inform the patient that hospital "A" has a top rating for gall bladder operations because it had a low number of complications during such operations in the past few years, but other than that historical fact, Siegrist cannot not guide the patient in deciding at the present time which hospital to select for his operation. Because the entire purpose of Siegrist is to analyze past performance data, Siegrist cannot inform this particular patient with information such as whether hospital "A" currently has its operating rooms completely booked for the next several days, or that hospital "A" has raised its fee substantially for this operation recently, or that the expert surgeon at hospital "A" is now at hospital "B." If one were to follow the hypothetical of the Office Action and imagine that the Siegrist data system were to be used by patients to select which hospital to go to, the result would be that the top-rated hospital would be swamped with more patients than it could handle while other hospitals nearby would be empty. This obviously would create chaos in the market and is one reason why a data analysis system such as in Siegrist does not serve as a market coordinating system as recited in the claims here. The multi-step ranking system set forth in claim 47 serves to match customers with service providers in an orderly, mutually satisfactory way. No functionality is provided in Siegrist for assigning the current flow of customers to service providers best able to accommodate the needs of both. It may be noted that the primary intended use of the Siegrist system is by hospitals for evaluating their own performance (see the first two paragraphs of Siegrist's specification). It is mere speculation in the Office Action that a patient would have access to and use Siegrist's data to select a hospital for a current medical need. In particular, it should be noted that claim 47 recites "obtaining service need information concerning a customer" for which there is no counterpart in Siegrist since Siegrist is not receiving current need information, but only past treatment information.

The Office Action is in error (on pages 6 and 7) in asserting that Siegrist includes analysis of time interval since last service preformed as recited in claim 47 here. For this, the Office Action points to data labeled as "Age" in Table IV; however, this has nothing to do with service interval, but rather the total patient age for a

particular hospital. See col. 8, lines 1-11, where it is stated that age of patients is part of the demographic data presented in Table IV. Therefore, there is nothing in Siegrist corresponding to the service interval which is included in the ranking method set forth in claim 47 here. This is further evidence that Siegrist is not concerned with a dynamic market system as in the present invention, but rather is only looking back at historical data.

The Office Action concedes that Siegrist does not disclose analysis of inducement data, a feature recited in claim 47 here, and turns to the Borghesi reference for that feature. Indeed, since Siegrist involves analyzing historical data, a factor such as current or future inducements would have no relevance whatsoever in the Siegrist context. Even if Borghesi taught such a feature (which, it is submitted, it does not), it would be inconsistent with the primary reference itself to impose that feature onto Siegrist. Furthermore, the basis provided by the Office Action as to why the teachings of Borghesi would be relevant to Siegrist is faulty. Siegrist deals with ways to fairly compare past cost performance data from different medical facilities, whereas Borghesi provides a software system for estimating the cost of repairing an automobile. The Office Action (at page 10) states that all of the cited references are analogous because "all involve aspects of calculating cost of performing a service." This statement is not accurate because estimating future costs as in Borghesi is not analogous to analyzing past costs as in Siegrist.

The Office Action has incorrectly interpreted the teaching of Borghesi regarding the involvement of discount information in the reference's system. The portion of Borghesi quoted in the paragraph bridging pages 7 and 8 of the Office Action (col. 4, lines 61-63 of Borghesi) refers to expenses of the service provider (the auto repair shop) that will be incurred by the shop in performing a repair. Therefore, the mention of "discounts" in that sentence of the reference clearly refers to discounts that the service provider receives from its suppliers, not inducements that it offers to its customers. Furthermore, even if Borghesi, for the sake of argument, were to offer discounts to customers of a repair shop, this factor would not be used in the way that inducements are used in the present claims because Borghesi does

not describe a system in which competing shops vie with each other for placement in a ranking system. Borghesi involves an electronic system for expediting repair estimates, insurance claims approvals, and payments for a given service provider – the reference does not deal with a market system as claimed here in which a customer is matched with a service provider from among many service providers. Therefore, there would be no purpose for including inducement information in the context of Borghesi.

In summary, it is submitted that Borghesi does not provide the features acknowledged to be missing from Siegrist, and even if it did, the suggested combination ignores several basic differences in the objectives of the references that render the references incompatible. Accordingly, it is submitted that the rejections of claims 47 – 52 based upon Siegrist in combination with Borghesi should be reconsidered and withdrawn.

The rejection of claims 49 and 50 under 35 USC 103 based on the Siegrist *et al.* reference (U.S. Pat. No. 5,652,842) ("Siegrist") in view of the Borghesi *et al.* reference (U.S. Pat. No. 5,950,169) ("Borghesi") further in view of "Electronic Commerce – A Manager's Guide" by R. Kalakota ("Electronic Commerce") is respectfully traversed. "Electronic Commerce" is cited for the feature recited in claim 49 of "billing the organization a fixed fee for each service coordination transaction." The tertiary reference merely indicates that e-commerce transactions may entail payments. However, it should be noted that claim 49 specifies that the entity that is charged the fee for the transaction is the "organization" -- i.e., an entity separate from the "service providers" and the "customer" as defined in claim 47. It is not seen that any of the references singly or in combination involve such a three-party marketplace arrangement, nor is an arrangement taught or suggested in which a third party separate from the service provider and the customer pays for the claimed

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marketplace transaction. Additionally, "Electronic Commerce" does not remedy any of the shortcomings in the Siegrist and Borghesi references pointed out above.

Respectfully submitted,



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